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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/005,514	11/06/2001	Michael Landau	59149-8002.US01	1534

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PERKINS COIE LLP  
P.O. BOX 2168  
MENLO PARK, CA 94026

EXAMINER
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VAN BRAMER, JOHN W

ART UNIT	PAPER NUMBER
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3622

MAIL DATE	DELIVERY MODE
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01/26/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/005,514	Applicant(s) LANDAU ET AL.	
	Examiner John Van Bramer	Art Unit 3622	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 November 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                                 |                                                                                         |
|---------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                            | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>041202</u> . | 6) <input type="checkbox"/> Other: _____                                                |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 101*

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 16-23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. A computer program on a computer readable media is considered data on a disk, which is non-functional descriptive material (See MPEP 2106). In order to meet the 35 USC 101 requirements the claimed invention must produce a "useful, concrete, and tangible result", and the invention as currently claimed is not capable of meeting these requirements. The invention is useful and concrete by virtue of the computer media on which it is stored. For example, a computer media such as a Floppy Disk is a physical object and therefore concrete. This concrete form could be used for many things such as a bookmark or drink coaster so it might be useful.

However, neither the computer media nor the computer program produces anything. A computer program is simply written text that is structured in such a way that a compiler can convert this text into machine-readable code. For example, following is a simple computer program with a module configured to print "I am a program!":

```
class SimpleProgram {  
    public static void main(String args[])  
    {  
        printmodule();  
    }  
}
```

```
        public printmodule();  
        {  
            System.out.println("I am a program!");  
        }  
    }
```

In its current state this computer program is not capable of producing anything. The first step in converting the computer program into patentable subject matter is that the computer program must be compiled into machine-readable code that a computing device can understand and storing it on a computer media. The act of compiling the program and storing it on a computer media results in software that is executable to perform the claimed steps, which, while still non-statutory, is considered functional descriptive material. At this point the invention is now capable of producing a tangible result but is not able to produce a tangible result as specified in the MPEP.

In order to produce a tangible result, the software must be loaded on a computing device that executes the program to perform the claimed steps. The only manner in which a tangible result will be realized is when the software is executed. Until such a time, the invention does not meet the 35 USC 101 requirements.

The examiner suggests amending the claims to read:

Claim 16: A computer program, stored on a computer readable medium that is interacting with a computer processor to provide performance based referral credit based on user transactions comprising:

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-53 are rejected under 35 U.S.C. 102(e) as being anticipated by Bezos et al. (US Patent Number: 6,029,141).

Claims 1,9,16,24,32,34,41,42,49,50, and 51: Bezos discloses a method, system, program, and apparatus for providing performance based referral credit based on user transactions utilizing a network comprising:

- a. Allowing a referring entity to present a publication, the referring entity being assigned a unique identifier associated with the publication. (Col 1, line 50 through Col 2, line 18; and Col 7, lines 6-40)
- b. Receiving input from a user for subscribing to the publication utilizing a network. (Col 7, lines 52-60)
- c. Assigning a tracking code that traces to the user input and the unique identifier. (Col 8, lines 17-48)

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- d. Forwarding the publication to the user based on the user input utilizing the network. (Col 7, lines 52-60)
- e. Allowing the user to select an entity associated with the publication. (Col 14, lines 1-37)
- f. Identifying the tracking code when the user conducts a transaction with the entity in order to provide a credit to the referring entity. (Col 1, line 50 through Col 2, line 18; and Col 14, line 38 through Col 15, line 16)

Claims 2, 10, 17, 25, 33, and 43: Bezos discloses a method, system, program, and apparatus as recited in claims 1, 9, 16, 24, 32, and 42 wherein the publication includes at least one of a newsletter and an e-mail announcement. (Col 1, line 50 through Col 2, line 18)

Claims 3, 11, 18, 26, 35, and 44: Bezos discloses a method, system, program, and apparatus as recited in claims 1, 9, 16, 24, 34, and 42 wherein the user input includes an email address. (Col 8, lines 17-48)

Claims 4, 12, 19, 27, 36, 45, and 52: Bezos discloses a method, system, program, and apparatus as recited in claims 1, 9, 16, 24, 32, and 42, wherein the entity associated with the publication is represented by at least one of a link, an advertisement, contact information, an input button, a script, and a drop down menu. (Col 7, lines 6-60)

Claims 5, 13, 20, 28, 37, and 46: Bezos discloses a method, system, program, and apparatus as recited in claims 1, wherein the network includes at least one of a wide area network and a local area network. (Col 11, lines 50-61)

Claims 6, 14, 21, 29, and 38: Bezos discloses a method, system, program, and apparatus as recited in claims 1, 9, 16, 24, 32, and 42, further comprising providing compensation for the credit of the referring entity. (Col 7, lines 6-60)

Claims 7, 15, 22, 30, 39, 47, and 53: Bezos discloses a method, system, program, and apparatus as recited in claims 6, 14, 21, 29, 32, 42 and 52, wherein the compensation includes monetary compensation, return referrals, discounted services, and no-charge services. (Col 7, lines 6-60)

Claims 8, 23, 31, 40, and 48: Bezos discloses a method, system, program, and apparatus as recited in claims 1, 9, 22, 24, 32, and 42, wherein the tracking code includes the unique identifier. (Col 14, line 38 through Col 15, line 16)

### ***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Van Bramer whose telephone number is

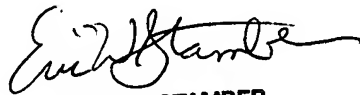
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(571) 272-8198. The examiner can normally be reached on 6am - 4pm Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
jvb

  
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